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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Broome *et al.*

Application No.: 09/723,003

Filed: November 27, 2000

For: DISTAL PROTECTION DEVICE
AND METHOD

Group Art Unit: 3765

Examiner: Larry Worrell

Attorney Docket No.: 10177-108

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**REQUEST UNDER 37 C.F.R. §§ 1.603 and 1.604(a)
FOR INTERFERENCE WITH AN APPLICATION**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. §§ 1.603 and 1.604(a), Applicants hereby seek to have an interference declared between the captioned application and Bates *et al.* Patent Application No. 09/774,197 (the "'197 application;" attached as Exhibit B), entitled "Emboli Filtration System Having Integral Strut Arrangement and Methods of Use," which was filed on January 29, 2001 and was published on August 9, 2001. The '197 application is a continuation-in-part of U.S. Patent No. 6,179,859 (the "'859 patent") to Bates *et al.*, which was filed on July 16, 1999.

The captioned application claims priority under 35 U.S.C. § 120 as a continuation of application Serial No. 09/035,740, filed March 5, 1998 (the "'740 application"), which issued as Patent No. 6,152,946 B1 on November 28, 2000. Applicants should be named senior party upon declaration of an interference because the claims of the captioned application are entitled to an effective filing date (March 5, 1998) prior to the earliest possible effective filing date of the claims of the '197 application (July 16, 1999).

In this Request, Applicants submit for the Examiner's consideration new claims 59-63 along with the following remarks. Claims 51-63 are pending with the submission of this Request.

On January 29, 2002, Applicants filed a Request Under 37 C.F.R. §§ 1.607 And 1.608(a) For Interference With A Patent ("First Request") in which they requested that an

interference be declared between the captioned application and the Bates *et al.* '859 patent, which is the "parent" of the '197 application. In that First Request, Applicants proposed a single count directed to the same patentable invention claimed in the captioned application and the '859 patent. No action has been taken on that First Request.

In this Request, Applicants further propose that the Bates *et al.* '197 application be added to that interference and claims 11, 12, 18 and 19 of the '197 application also be designated to correspond to the count, "proposed count 1," of the First Request. As well, newly added claims 51-62 of the captioned application should be designated as corresponding to proposed count 1. Additionally, Applicants propose in this Request to add in the same interference a second count ("proposed count 2") directed to a separately patentable invention from proposed count 1. Claim 63 of the captioned application and claim 20 of the '197 application should be designated to correspond to proposed count 2.

IN THE CLAIMS:

Please add claims 59-63:

59. (new) Apparatus for filtering emboli from blood flowing through a vessel, the apparatus comprising:

- a guide wire having a distal region;
- a filter element disposed for rotation on the distal region of the guide wire, the filter element comprising a self-expanding strut and a filter sac connected to the self-expanding strut; and
- a distal stop disposed on the distal region distal to the filter element, the distal stop limiting distal translation of the filter element on the guide wire.

60. (new) The apparatus of claim 59 wherein, when the filter sac is deployed in the vessel, rotation of the guide wire does not displace the filter element.

61. (new) A method of filtering emboli from blood flowing through a vessel, the method comprising:

- providing a guide wire having a distal region including a distal stop, and a filter element disposed for translation on the guide wire proximal to the distal stop, the filter element comprising a plurality of self-expanding struts having a filter sac affixed thereto;
- transluminally inserting the guide wire and filter element into a vessel;
- deploying the filter element so that the struts and filter sac expand to engage a wall

of the vessel, the filter sac filtering emboli out of blood flowing through the vessel; and

advancing a treatment device along the guide wire to treat a portion of the vessel proximal to the location of the filter element, rotation or distal translation of the guide wire relative to the filter element imparted by the treatment device not displacing the filter element.

62. (new) The method of claim 61 further comprising retracting the guide wire in a proximal direction to cause the distal stop to abut against the filter element.

63. (new) The method of claim 61 further comprising:
providing a retrieval catheter having a recovery sock;
advancing the retrieval catheter over the guide wire until the recovery sock covers a mouth of the filter element; and
urging the retrieval catheter against the self-expanding struts of the filter element to cause the filter element to collapse.

REMARKS

Upon entry of this Request, claims 51-63 will be pending. Claims 1-50 have been previously canceled. Claims 59-63 have been added by this Request.

I. BACKGROUND

The interfering subject matter of proposed count 1 (of the First Request) relates to an apparatus for filtering emboli from blood, comprising a guide wire having a stop on its distal region; a capture ring disposed for translation on the guide wire, the stop limiting translation of the capture ring in a distal direction; and a filter sac connected to the capture ring.

The interfering subject matter of proposed count 2 (of this Request) relates to a method of retrieving the filter apparatus by advancing a retrieval catheter with a recovery sock over the guide wire until the recovery sock covers a mouth of the filter apparatus and urging the retrieval catheter against the struts of the filter apparatus to cause the filter apparatus to collapse for retrieval.

II. PROPOSED COUNTS AND DESIGNATED CLAIMS

A. The Proposed Counts

Applicants previously proposed the following count in the First Request:

PROPOSED COUNT 1

Apparatus for filtering emboli from blood flowing through a vessel, the apparatus comprising:

- a guide wire having a distal region and a stop on the distal region;
- a capture ring disposed for translation on the guide wire, the stop limiting translation of the capture ring in a distal direction; and
- a filter sac connected to the capture ring.

Proposed count 1 is identical to claim 1 of the '859 patent. This is consistent with 37 C.F.R. § 1.606, which provides that "[a]t the time an interference is initially declared (§ 1.611), a count shall not be narrower in scope than any . . . patent claim designated to correspond to the count."

Applicants propose count 2 in this Request.

PROPOSED COUNT 2

A method for filtering emboli from blood flowing through a vessel, the method comprising:

- providing a guide wire having a distal region including a distal stop, a filter element disposed for translation on the guide wire proximal to the distal stop, the filter element comprising a plurality of self-expanding struts having a filter sac affixed thereto;
- transluminally inserting the guide wire and filter element into a vessel;
- deploying the filter element so that the struts and filter sac expand to engage a wall of the vessel, the filter sac filtering emboli out of blood flowing through the vessel;
- advancing a treatment device along the guide wire to treat a portion of the vessel proximal to the location of the filter element, rotation or distal translation of the guide wire relative to the filter element imparted by the treatment device not displacing the filter element;
- providing a retrieval catheter having a recovery sock;
- advancing the retrieval catheter over the guide wire until the recovery sock

covers a mouth of the filter element; and
urging the retrieval catheter against the self-expanding struts of the filter
element to cause the filter element to collapse.

Proposed count 2 is identical to claim 20 of the '197 application except that it has
been rewritten in independent form with all of the limitations of claim 18 of the '197
application. This is also consistent with the provisions of 37 C.F.R. § 1.606.

B. Proposed Count 2 Is Separately Patentable From Proposed Count 1

Proposed count 2 is separately patentable from proposed count 1 because it is directed to
a specific method for retrieving an apparatus for filtering emboli from blood while proposed
count 1 is directed to an apparatus for filtering blood. After a blood filtration apparatus has been
used to collect embolic material, it must be removed from the blood vessel. The methods of
removing a used filtration apparatus are not obvious from the apparatus described by proposed
count 1. Proposed count 2 is directed towards one such nonobvious method for removing a used
filtration apparatus involving the use of a retrieval catheter having a recovery sock that covers
the mouth of the filter apparatus, causing the filter to collapse so that it can be withdrawn from
the blood vessel.

**C. Claims 11, 12, 18 And 19 Of The '197 Application Should
Be Designated To Correspond To Proposed Count 1**

Claims 11, 12, 18 and 19 of the '197 application should be designated to
correspond to proposed count 1 since all are directed to the same patentable invention.
37 C.F.R. § 1.601(n).

1. Claims 11 And 12 Are The Same Invention As Proposed Count 1

Independent claim 11 is directed to the same patentable invention as proposed
count 1. Claim 12 depends from claim 11 and does not add any limitation that defines an
invention separately patentable from claim 11, as discussed below.

Claim 11 differs from proposed count 1 by using different terminology for
elements of proposed count 1 and by adding an obvious element to proposed count 1.
Specifically, claim 11 uses the term "filter element" which encompasses the capture ring and
filter sac elements of proposed count 1. Renaming the elements of the claim does not define a
separately patentable invention. Proposed count 1 requires that the filter sac be connected to the
"capture ring" and the capture ring be disposed for translation on the guide wire such that the
distal stop limits translation of the capture ring in a distal direction. Claim 11 recites all
limitations of proposed count 1 but does not name that part of the filter element, the "capture

ring,” that allows translation of the filter sac along the guide wire and limits distal translation of the filter sac by abutting against the distal stop. As discussed above, the change in terminology does not define a separately patentable invention over proposed count 1. Additionally, claim 11 requires that the filter element be disposed for rotation on the guide wire while proposed count 1 requires that the filter element be disposed for translation on the guide wire. Freedom to rotate and freedom to translate are related properties in the context of this invention. In order for a filter apparatus to be able to translate or rotate on a guide wire, it must not be fixably attached to the guide wire. A filter apparatus that is disposed on the guide wire with freedom to translate will also be able to rotate around the guide wire. Thus, there is nothing nonobvious about reciting that the apparatus of proposed count 1, which is able to translate on the guide wire, also be able to rotate on the guide wire. Claim 11 further differs from proposed count 1 by requiring that a self-expanding strut be connected to the filter sac. The use of one or more self-expanding struts connected to a filter element is conventional in the art. See, for example, Patent No. 5,910,154 to Tsugita *et al.* (attached as Exhibit D), Figures 6A and 6B, described at column 12, lines 11-15 and 33-37. Use of a self-expanding strut in the filter element does not define a separately patentable invention. Thus, claim 11 should be designated as corresponding to proposed count 1.

Claim 12 adds the limitation to claim 11 that when the filter sac is deployed in the vessel, rotation of the guide wire does not displace the filter element. Deployment of the filter sac results in the filter being abutted to the wall of the vessel lumen in a stationary position. Since claim 11 requires that the filter apparatus be disposed for rotation on the guide wire, it is logical that the guide wire can also rotate without affecting the filter apparatus once it is stationarily deployed. Thus, there is nothing nonobvious about this additional recitation of claim 12 and claim 12 should be designated as corresponding to proposed count 1.

2. Claims 18 And 19 Are The Same Invention As Proposed Count 1

Independent claim 18 is directed to the same patentable invention as proposed count 1. Claim 19 depends from claim 18 and does not add any limitation that defines an invention separately patentable from claim 18, as discussed below.

Claim 18 differs from proposed count 1 in that claim 18 is a method of filtering emboli from blood as opposed to an apparatus for filtering emboli. Since this is the only use for such an apparatus, and the method is conventional in the art, the method of claim 18 is nonobvious over proposed count 1. Specifically, claim 18 recites providing a filter element disposed for translation on a guide wire. As discussed above with regards to claim 11, the “filter

element” of claim 18 is a change in nomenclature, not a change in structure. The filter element functions the same as the capture ring and filter sac of proposed count 1 and does not define a separately patentable invention over that count. Claim 18 also differs from the proposed count by requiring a plurality of self-expanding struts. As discussed above, a filter element having a filter supported on a plurality of self-expanding struts is old in the art. See, for example, Patent No. 5,910,154 to Tsugita *et al.* (attached as Exhibit D), Figures 6A and 6B, described at column 12, lines 11-15 and 33-37. Therefore, having a plurality of self-expanding struts does not make claim 18 separately patentable over proposed count 1. Additionally, claim 18 provides for inserting the apparatus transluminally into a vessel, deploying the filter element to engage a wall of the vessel to filter emboli, and advancing a treatment device along the guide wire to treat a portion of the vessel proximal to the filter element. All of these steps are conventional in the art. The purpose of the invention embodied in proposed count 1 is for filtering emboli out of the blood. The embolic material necessarily is produced by some activity proximal to the filtration apparatus. Thus, the step of “advancing a treatment device” along the guide wire to treat the proximal portion of the vessel does not constitute a separate invention because such treatment activities have a causal relationship to the use of a filtration apparatus. Claim 18 also differs from the proposed count by stating that rotation or distal translation of the guide wire relative to the filter element does not displace the filter element. As discussed above, if the filter apparatus is free to translate along the guide wire (as specified in proposed count 1), there is nothing nonobvious about the necessary result that rotational or transnational movement of the guide wire does not displace the deployed (expanded) filter element.

Claim 19 adds the limitation to claim 18 that retracting the guide wire in a proximal direction causes the distal stop to abut against the filter element. Since the stop limits translation of the filter apparatus in the distal direction, it is logical that retracting the guide wire proximally will cause the stop to abut against the filter element. Thus, the limitation added by claim 19 is obvious and necessarily follows from the structure recited in proposed count 1.

Therefore, claims 18 and 19 should be designated as corresponding to proposed count 1.

D. Claim 20 Of The '197 Application Should Be Designated To Correspond To Proposed Count 2

Claim 20 of the '197 application should be designated to correspond to proposed count 2 since it is directed to the same patentable invention. 37 C.F.R. § 1.601(n).

Claim 20 of the '197 application is identical to proposed count 2 except that claim 20 is dependant on claim 18. Proposed count 2 has been written in independent form with

all of the limitations of claim 18 of the '197 application. Thus, as claim 20 is identical to proposed count 2 it is directed to the same patentable invention.

For this reason, claim 20 should be designated to correspond to proposed count 2.

**E. Claims 59-63 Of The Captioned Application
Are Supported In Applicants' Specification**

CLAIM 59: Support for claim 59 is found at page 1, lines 11-15; page 15, lines 16-18, 26-28, and 31-32; page 16, lines 8-11; page 18, lines 3-7 and 22-25; and page 19, lines 7-13, quoted below, and Figure 18.

59. Apparatus for filtering emboli from blood flowing through a vessel, the apparatus comprising:	The present invention deals with an emboli capturing system and method for capturing embolic material in a blood vessel during an atherectomy or thrombectomy procedure. (p. 1, ll. 11-15)
a guide wire having a distal region;	Guidewire 210 is formed of an elongated wire 212, preferably having a spring coil tip 214, and a protective device docking member 216 coupled to a distal portion of wire 212, as illustrated in FIG. 17. (p. 18, ll. 3-6)
a filter element disposed for rotation on the distal region of the guide wire, the filter element comprising	FIG. 18 illustrates an embodiment of a protection device 230 which may be selectively coupled to docking member 216. (p. 18, ll. 22-24; Fig. 18)
a self-expanding strut	Device 230 [] is deployed [] similar to that previously described with reference to FIGS. 13-14. (p. 19, ll. 7-13) Frame 154 includes a generally circular mouth member 170 and a plurality of struts or ribs 172. (p. 15, ll. 31-32) Preferably, frame 154 (mouth 170 and struts or ribs 172) are formed of a wire or strip of a relatively elastic material such as a Nitinol material. (p. 16, ll. 8-11)
and a filter sac connected to the self-expanding strut;	Device 230 [] is deployed [] similar to that previously described with reference to FIGS. 13-14. (p. 19, ll. 7-13) Protection device 230 includes [] a filter 152. (p. 18, ll. 24-25) Filter 152 is preferably a cone-shaped member

	<p>having proximal and distal ends 158, 160. (p. 15, ll. 16-18)</p> <p>Proximal end 158 includes an opening which is supported relative to frame 154 to form a mouth of the device. (p. 15, ll. 26-28)</p>
and a distal stop disposed on the distal region distal to the filter element,	<p>a protective device docking member 216 coupled to a distal portion of wire 212, as illustrated in FIG. 17. (p. 18, ll. 5-7)</p>
the distal stop limiting distal translation of the filter element on the guide wire.	<p>device 230 which may be selectively coupled to docking member 216. (p. 18, ll. 23-24; Fig. 18)</p>

In the context of the captioned application, the phrase “capturing emboli” refers to removing emboli by filtration using a filter placed within a blood vessel. See, for example, the discussion at page 3, line 27 to page 4 line 2, and the general discussion of filters at page 9, lines 15-26. Generally, the distal “stop” of the claims of the ’197 application correspond to the distal “docking member” 216 of Figures 17-20 of the captioned application. The docking member 216 functions as a stop to limit translation of the distal cone 232 in a distal direction. The filtration apparatus has a frame 154 with a plurality of struts 172. The struts are formed of an elastic material such as Nitinol which biases the filter to expand when it is deployed. As noted above and shown in Figure 18, the distal cone 232 of the filter sac may or may not be coupled to the docking member 216. The filter 152 is attached to the distal cone 232. When it is not coupled, the distal cone and filter sac freely rotate and distally translate (or advance) on the guide wire 210 in both the collapsed and deployed state.

CLAIM 60: Support for claim 60 is found at page 18, lines 23-24, quoted below, and Figure 18.

<p>60. The apparatus of claim 59 wherein, when the filter sac is deployed in the vessel, rotation of the guide wire does not displace the filter element.</p>	<p>device 230 which may be selectively coupled to docking member 216. (p. 18, ll. 23-24; Fig. 18)</p>
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As noted above and shown in Figure 18, the distal cone 232 of the filter sac may or may not be coupled to the docking member 216. When it is not coupled, the distal cone and

filter sac freely rotate and distally translate (or advance) on the guide wire 210 in both the collapsed and deployed state.

CLAIM 61: Support for claim 61 is found at page 1, lines 11-15; page 3, lines 11-17; page 15, lines 16-18, 22-24, 26-28, and 31-32; page 16, lines 1 and 27-29; page 17, lines 1-2; page 18, lines 3-6 and 22-25; and page 19, lines 1-4 and 7-13, quoted below, and Figure 18.

61. A method of filtering emboli from blood flowing through a vessel, the method comprising:	The present invention deals with an emboli capturing system and method for capturing embolic material in a blood vessel during an atherectomy or thrombectomy procedure. (p. 1, ll. 11-15)
providing a guide wire having a distal region including a distal stop,	Guidewire 210 is formed of an elongated wire 212, preferably having a spring coil tip 214, and a protective device docking member 216 coupled to a distal portion of wire 212, as illustrated in FIG. 17. (p. 18, ll. 3-6)
and a filter element disposed for translation on the guide wire proximal to the distal stop,	device 230 is mounted relative to the guidewire by inserting guidewire 210 through an opening in cone 232. Device 230 is advanced over guidewire 210 to align cone 232 with docking member 216. (p. 19, ll. 1-4)
the filter element comprising a plurality of self-expanding struts having a filter sac affixed thereto;	<p>Device 230 [] is deployed [] similar to that previously described with reference to FIGS. 13-14. (p. 19, ll. 7-13)</p> <p>Frame 154 includes a generally circular mouth member 170 and a plurality of struts or ribs 172. (p. 15, ll. 31-32)</p> <p>Protection device 230 includes [] a filter 152. (p. 18, ll. 24-25)</p> <p>Filter 152 is preferably a cone-shaped member having proximal and distal ends 158, 160. (p. 15, ll. 16-18)</p> <p>Proximal end 158 includes an opening which is supported relative to frame 154 to form a mouth of the device. (p. 15, ll. 26-28)</p>

transluminally inserting the guide wire and filter element into a vessel;	insertion sheath 64 and device 150 are inserted into a patient and located distal of a stenosis 62 for deployment. (p. 16, ll. 27-29)
deploying the filter element so that the struts and filter sac expand to engage a wall of the vessel,	to expand mouth 170 to conform to the vessel walls 60 as illustrated in FIG. 14. (p. 16, l. 34-p. 17, l. 2)
the filter sac filtering emboli out of blood flowing through the vessel;	Material and debris generally collect at the "V"-shaped tip [of] filter 152. (p. 15, ll. 22-24)
advancing a treatment device along the guide wire to treat a portion of the vessel proximal to the location of the filter element,	A final technique for dealing with the fragments severed during atherectomy of the stenosis is placement of a device distal to the stenosis during atherectomy to catch the pieces of the stenosis as they are severed, and removal of those pieces along with the capturing device when the atherectomy procedure is complete. (p. 3, ll. 11-17)
rotation or distal translation of the guide wire relative to the filter element imparted by the treatment device not displacing the filter element.	device 230 which may be selectively coupled to docking member 216. (p. 18, ll. 22-24; Fig. 18)

In the context of the captioned application, the phrase "capturing emboli" refers to removing emboli by filtration using a filter placed within a blood vessel. See, for example, the discussion at page 3, line 27 to page 4 line 2, and the general discussion of filters at page 9, lines 15-26. Generally, the distal "stop" of the claims of the '197 application correspond to the distal "docking member" 216 of Figures 17-20 of the captioned application. The docking member 216 functions as a stop to limit translation of the distal cone 232 in a distal direction. As noted above and shown in Figure 18, the distal cone 232 of the filter sac may or may not be coupled to the docking member 216. The filter 152 is attached to the distal cone 232. When it is not coupled, the distal cone and filter sac freely rotate and distally translate (or advance) on the guide wire 210 in both the collapsed and deployed state. The filtration apparatus has a frame 154 with a plurality of struts 172. The struts are formed of a elastic material such as Nitinol which biases the filter to expand when it is deployed. Once the apparatus is deployed, the filter element expands to conform to the walls of the vessel so that it can collect debris.

The captioned application describes several procedures that may generate embolic debris which require filtration to prevent that embolic material from becoming lodged in smaller blood vessels distal to the procedure. For example, at page 2, lines 1-12, the captioned application described the use of radio frequency signal, lasers, and mechanical abrasion to treat blocked or narrowed blood vessels. Such techniques may create embolic debris which could cause blood clots if not captured. The filtration apparatus described by proposed count 1 is deployed distally (downstream) from the treatment procedure to capture the embolic material to prevent blood clots or other complications. One of skill in the art at the time that the invention was made would have understood that the filtration apparatuses and methods of using the filtrations apparatuses would be used in the context of treating occluded or narrowed blood vessels as described in the captioned application.

CLAIM 62: Support for claim 62 is found at page 19, lines 1-4, quoted below.

<p>62. The method of claim 61 further comprising retracting the guide wire in a proximal direction to cause the distal stop to abut against the filter element.</p>	<p>Thus, device 230 is mounted relative to the guidewire by inserting guidewire 210 through an opening in cone 232. Device 230 is advanced over guidewire 210 to align cone 232 with docking member 216. (p. 19, ll. 1-4)</p>
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As discussed above, the filter apparatus is able to translate on the guide wire but its distal translation is limited by the docking member or distal stop. Retraction of the guide wire will necessarily cause the distal stop to come into contact with the filter apparatus.

CLAIM 63: Support for claim 63 is found at page 20, lines 13-15 and 29-31 and page 21, lines 3-12 and figure 21, quoted below.

<p>63. The method of claim 61 further comprising:</p>	
<p>providing a retrieval catheter having a recovery sock;</p>	<p>Flanged end 308 has a relatively large tapered mouth for capturing and progressively collapsing a deployed protection device. (p. 20, ll. 13-15, Fig. 21)</p> <p>Flanged end 308 may be formed of a pleated material or simply a relatively elastic material.</p>

	(p. 20, ll. 29-31)
advancing the retrieval catheter over the guide wire until the recovery sock covers a mouth of the filter element;	Once retrieval device 280 is aligned, inner tube 284 is slid distally relative to outer tube 282 to expand flanged end 308 to an expanded profile, as illustrated in FIG. 21, to surround the deployed protection device. (p. 21, ll. 3-7)
and urging the retrieval catheter against the self-expanding struts of the filter element to cause the filter element to collapse	Thereafter, sheath 280 may be advanced, or protection device 282 may be withdrawn proximally via guidewire 32 to forcibly collapse protection device 282 as protection device 282 is withdrawn along the tapered inner channel of flanged end 308. (p. 21, 7-12).

In the context of the captioned application, a retrieval sheath 280 with a flanged end 308 is advanced over the distal end of the distal protection device 282. The pressure exerted by the retrieval sheath on the protection device causes the protection device to collapse for withdrawal into the inner channel of the of the retrieval sheath. See, for example, the discussion at page 19, line 23 through page 21, line 22 and Figure 21.

F. Applicants' Claims 59-62 Should Be Designated To Correspond To Proposed Count 1 And Claim 63 Should Be Designated To Correspond To Proposed Count 2

The following table presents the correspondence between claims 59-63 of the captioned application and identical claims of the '179 application:

<u>'197 Application</u>	<u>Captioned Application</u>
11	59
12	60
18	61
19	62
20	63

Applicants' claims 59-62 correspond substantially to proposed count 1. In the section above, entitled "Claims 11, 12, 18 And 19 Of The '197 Application Should Be Designated To Correspond To Proposed Count 1," Applicants presented reasons why claims 11, 12, 18 and 19 of the '197 application are directed to the same patentable invention as proposed count 1. Since Applicants' claims 59-62, respectively, are identical to those claims of the '197

application, they should be designated to correspond to proposed count 1 for the same reasons. Additionally, Applicants' claim 63 corresponds to proposed count 2. In the section above, entitled "Claim 20 Of The '197 Application Should Be Designated To Correspond To Proposed Count 2," Applicants explained that claim 20 of the '197 application is directed to the same patentable invention as proposed count 2. Since Applicants' claim 63 is identical to claim 20 of the '197 application, claim 63 should be designated to correspond to proposed count 2 for the same reasons.

III. APPLICANTS ARE ENTITLED TO THE BENEFIT OF THE MARCH 5, 1998 FILING DATE OF THEIR PARENT APPLICATION FOR BOTH PROPOSED COUNTS

Since the captioned application is a continuation application of the '740 application, both applications are identical. The above showing of support in the captioned application applies here to establish support in the '740 application as well. Additionally, there was co-pendency between the two applications since the captioned application was filed November 27, 2000, one day before the '740 application issued as a patent.

Thus, Applicants are entitled to the benefit of the March 5, 1998 filing date of their '740 application because that application meets the Section 112, first paragraph, written description and enablement requirements of at least one species within each proposed count. *Squires v. Corbett*, 560 F.2d 424, 433, 194 USPQ 513, 519 (C.C.P.A. 1977); *Weil v. Fritz*, 572 F.2d 856, 865-66 n.16, 196 USPQ 600, 608 n.16 (C.C.P.A. 1978).

IV. THE EARLIEST POSSIBLE EFFECTIVE DATE FOR BATES *et al.* APPLICATION SERIAL NO. 09/774,197 IS JULY 16, 1999

The '197 application is a continuation-in-part of United States Patent No. 6,179,859. The '859 patent has no claim to priority under 35 U.S.C. §§ 119 or 120. Therefore, the earliest possible effective filing date for the '197 application is the date that the '859 patent was filed, July 16, 1999.

V. APPLICANTS SHOULD BE THE SENIOR PARTY UPON DECLARATION OF AN INTERFERENCE

Applicants should be the senior party because their effective filing date is earlier than the earliest possible effective filing date for Bates *et al.* As discussed above, Applicants are entitled to an effective filing date of March 5, 1998 while the earliest possible effective filing date for Bates *et al.* is July 16, 1999. Thus, Applicants have an earlier effective filing date and should be the senior party upon declaration of an interference.

**VI. 35 U.S.C. § 135(B) IS NOT AN IMPEDIMENT
TO PRESENTING NEW CLAIMS 59-61**

The provision of 35 U.S.C. § 135(b)(2) is not an impediment to adding Applicants' new claims because it applies only to claims added to applications filed after the publication date application from which the claims are "copied" and, here, the captioned application was filed (on November 27, 2000) before the publication date of the *Bates et al.* '197 application (August 9, 2001). In any event, the new claims were added to this application within one year of the publication (August 9, 2001) of the '197 application under 35 U.S.C. § 122(b).

**VII. APPLICANTS' APPLICATION SERIAL NO. 10/060,125 IS A
CONTINUATION OF THE CAPTIONED APPLICATION
THAT CLAIMS SEPARATELY PATENTABLE INVENTIONS**

On January 29, 2002, Applicants filed a continuation of the captioned application that claims separately patentable inventions from the inventions claimed in the captioned application. Applicants direct the Examiner's attention to application Serial No. 10/060,125 for verification that its claims should not be designated to correspond to either of the proposed counts discussed in this Request.

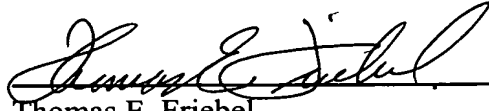
CONCLUSION

Applicants have demonstrated that the interference they proposed in their First Request should also involve *Bates et al.* application No. 09/774,197. The two counts in that interference should be Applicants' proposed counts 1 and 2. Proposed count 1 is identical to claim 1 of the '859 patent and proposed count 2 is identical (but for it being rewritten in independent form) to claim 20 of the '197 application. As discussed in Applicant's First Request, Applicants' claims 51-58 and *Bates et al.* claims 1-26 should be designated as corresponding to proposed count 1. For the reasons discussed in this Request, Applicants' new claims 59-62 and *Bates et al.* claims 11, 12, 18 and 19 of the '197 application should also be designated as corresponding to proposed count 1. Additionally, Applicant's claim 63 and *Bates et al.* claim 20 of the '197 application should be designated as corresponding to proposed count 2. Moreover, Applicants should be accorded the benefit of the filing date of application Serial No. 09/035,740, filed March 5, 1998, for both proposed counts. The '197 application

should be accorded a filing date no earlier than July 16, 1999. Therefore, Applicants should be named senior party.

Respectfully submitted,

Date July 30, 2002


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Attachments:

- Exhibit A: List of pending claims 51-63
- Exhibit B: Bates *et al.*, Patent Application Publication No. US 2001/0012951 corresponding to application 09/774,197 (the “197 application”)
- Exhibit C: Broome *et al.*, Patent No. 6,152,946
- Exhibit D: Tsugita *et al.*, Patent No. 5,910,154